

REMARKS

The applicants have carefully considered the official action dated May 14, 2008. In view of the following remarks, the applicants respectfully request reconsideration of this application.

As an initial matter, the applicants maintain their traversal of the restriction requirement set forth in the official action dated February 5, 2008. To reiterate, the examiner has not demonstrated that a serious burden would be placed on the examiner if election were not required (as necessary according to MPEP § 803). No explanation of separate classification, separate status in the art, or a different field of search has been provided. Further, despite the examiner's attempt to treat the claim groups as combination and sub-combination under MPEP § 806.05, the record does not provide any basis or support for such a showing, as required by MPEP § 806.05. Nor has the examiner addressed or responded to applicants' arguments regarding the restriction requirement. Thus, applicants respectfully request careful reconsideration of the restriction requirement.

Rejections under 35 U.S.C. § 103(a)

Claim 40 was rejected as unpatentable under 35 U.S.C. §103(a) over Gorman (U.S. Patent No. 6,141,356) in view of Mannering et al. (U.S. Patent No. 6,137,839). The applicants respectfully traverse this rejection.

The Gorman patent issued from an application filed on November 10, 1997, and was not published until issued on October 31, 2000. However, because the instant application claims priority to its parent application, which was filed on February 16, 1999, the Gorman patent only qualifies as prior art under 35 U.S.C. §102(e). At the time of the instant invention, both the Gorman patent and the instant application were owned by the same

U.S. Serial No. 10/717,102
Response to the office action dated May 14, 2008

assignee or under an obligation to be assigned to the same assignee (i.e., Ameritech Corporation). This common ownership is documented by the attached assignment records of the USPTO (Exhibits A & B). Exhibits A & B are taken from reel/frame 018506/0931 and reel/frame 009071/0057. Therefore, as a matter of law, the Gorman patent is disqualified as prior against this application under 35 U.S.C. § 103. As a result, all of the art rejections based on the Gorman patent are in error and must be withdrawn.

Claims 21, 22, 24, 25, 38, 39, and 41 were rejected as unpatentable under 35 U.S.C. §103(a) over Mannerling et al. in view of Gitlin et al. (U.S. Patent No. 6,064,662). “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. Independent claim 21 recites a plurality of digital filters to convey a signal via an available frequency band associated with multiple independent channels. In the official action, the examiner asserts that Mannerling et al. describe a plurality of digital filters. However, as previously illustrated in the applicants’ response to the official action of August 8, 2007, Mannerling et al. do not describe or suggest digital filters. In fact, the examiner has previously stated that Mannerling et al. fail to describe one or more digital filters. See, the prosecution history of the parent application (U.S. Serial No. 09/251,097, issued as U.S. Patent No. 6,687,261), the official action dated October 10, 2002, page 5 (“Mannerling fails to teach the digital filter”).

The examiner now asserts that the system described by Mannerling et al. includes a plurality of digital filters and references the filters labeled with reference numerals 174 and 176 of FIG. 1B. However, the examiner was correct in his original assertion that Mannerling et al. fail to describe a digital filter. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974) (“All of the words in a claim must be considered in judging the patentability of that claim against the

prior art.”). Given the lack of any such description, Mannering et al. certainly do not describe a plurality of digital filters to convey a signal via an available frequency band, as recited in claim 21. In fact, Mannering et al. do not include any description of the filters (174 and 176 of FIG. 1B) cited in the present official action. Rather, the filters described by Mannering et al. are merely listed as components of a modem at the introduction of the modem and not mentioned again.

As further evidence that Mannering et al. do not describe digital filters, FIG. 1B of the Mannering et al. patent shows the first filter 174 receiving a signal from a digital-to-analog converter (DAC) 170, which, by definition, outputs an analog signal. FIG. 1B also shows the second filter 176 outputting a signal to an analog-to-digital converter (ADC) 172, which, by definition receives an analog signal. In sum, the filters referenced by the examiner receive and output analog signals. Therefore, not only does the Mannering et al. patent lack a description of digital filters, the filters cited in the Office action are explicitly illustrated as analog filters.

Gitlin et al. do not cure the deficiencies of Mannering et al. Specifically, Gitlin et al. do not describe or suggest digital filters to convey a signal via an available frequency band associated with the multiple independent channels. The system described by Gitlin et al. does not include any type of filter. Rather, Gitlin et al. describe allocating time-frequency slices to optimize use of a medium. Consequently, the obviousness rejections of these claims and all claims dependent thereon must be withdrawn and these claims are in condition for allowance.

Further, the official action fails to provide any factual evidence or reasoning to support a finding of obviousness over Mannering et al. in view of Gitlin et al. To support such rejections, the examiner bears the initial burden of factually supporting a *prima facie*

conclusion of obviousness. See, M.P.E.P. 2142. Further, as recognized by the Supreme Court of the United States, the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in KSR (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). Here, no motivation to combine or rationale has been asserted or factually supported.

In the official action, the examiner states that “it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to implement the method of signals into the available frequency band in order to transmit in channels.” See, the official action dated May 14, 2008, pages 2-3. Nothing further in support of the prima facie case of obviousness (in regards to Mannering et al. and Gitlin et al.) appears in the official action.

Given the lack of any further explanation or rationale, this statement does not establish a prima facie case of obviousness. In fact, the statement appears to be an incomplete sentence having no clear assertion or meaning. Because the official action fails to provide evidence, reasoning, or an articulation for the record regarding the alleged obviousness of independent claim 21, the §103(a) rejection thereof, along the rejections of any claim dependent thereon, must be withdrawn.

U.S. Serial No. 10/717,102
Response to the office action dated May 14, 2008

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed (if any) or any additional fees which may be required during the pendency of this application to Deposit Account No. 50-2455.

Respectfully submitted,
HANLEY, FLIGHT & ZIMMERMAN, LLC
150 South Wacker Drive
Suite 2100
Chicago, Illinois 60606

September 8, 2008

/Daniel J. Glitto/

Daniel J. Glitto
Registration No. 58,996
Attorney for Applicant(s)